

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION**

WI-LAN INC. and WI-LAN USA, INC.,

Plaintiffs,

v.

RESEARCH IN MOTION LIMITED and
RESEARCH IN MOTION CORPORATION,

Defendants.

Civil Action No. _____

JURY TRIAL DEMANDED

COMPLAINT

This is a complaint for patent infringement. The patents-in-issue include U.S. Patent Nos. 8,184,661 and 8,274,991. Plaintiffs, Wi-LAN Inc. and Wi-LAN USA, Inc., for their Complaint state as follows:

PARTIES

1. Plaintiff Wi-LAN Inc. is a corporation existing under the laws of Canada with its principal place of business at 11 Holland Ave., Suite 608, Ottawa, Ontario, Canada K1Y 4S1. Wi-LAN Inc. is a publicly traded leading technology innovation and licensing company actively engaged in research, development, and licensing of wireless and digital display technologies. Plaintiff Wi-LAN USA, Inc. is a corporation existing under the laws of the state of Florida with its principal place of business at 175 S.W. 7th Street, No. 1803, Miami, Florida 33130. Wi-LAN USA, Inc. is a wholly owned

subsidiary of Wi-LAN Inc. Plaintiffs will be collectively referred to herein as “Wi-LAN.”

2. Upon information and belief, Defendant Research In Motion Limited is a corporation organized and existing under the laws of Ontario, Canada with its principal place of business at 295 Phillip Street, Waterloo, Ontario, Canada, N2L 3W8. Defendant Research In Motion Limited directly or indirectly through subsidiaries or affiliated companies markets, distributes, manufactures, imports, sells, and/or offers to sell consumer electronic products, including mobile phones, tablets, accessories, and associated equipment and software, in this judicial district and throughout the United States. Upon information and belief, Defendant Research In Motion Limited may have changed its corporate name or may now be doing business as “BlackBerry.”

3. Upon information and belief, Defendant Research In Motion Corporation is a corporation organized and existing under the laws of the state of Delaware with a principal place of business at 5000 Riverside Drive, Irving, Texas 75039. Defendant Research In Motion Corporation directly or indirectly through subsidiaries, parents, or affiliated companies markets, distributes, manufactures, imports, sells, and/or offers to sell consumer electronic products, including mobile phones, tablets, accessories, and associated equipment and software, in this judicial district and throughout the United States. Upon information and belief, Defendant Research In Motion Corporation may have changed its corporate name or may now be doing business as “BlackBerry.”

4. Upon information and belief, Defendant Research In Motion Corporation is a wholly owned subsidiary of Defendant Research In Motion Limited and is the

managing entity of the United States operations of Defendant Research In Motion Limited. Upon information and belief, Defendant Research In Motion Limited and Defendant Research In Motion Corporation share, at least some, directors and/or officers. Upon information and belief, Defendant Research In Motion Limited exercises operational control over Defendant Research In Motion Corporation.

JURISDICTION

5. This action for patent infringement arises under the Patent Act, 35 U.S.C. § 271, *et seq.* This Court has subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1338(a).

6. This Court has personal jurisdiction over Defendants. Defendants have engaged in business in this judicial district, have at least one office in this judicial district, and have committed or caused tortuous injury in this judicial district. Defendants have additionally engaged in substantial and not isolated activity within this state. Upon information and belief, Defendants have distributed and/or sold and continue to distribute and/or sell large volumes of mobile phones and tablets into this judicial district.

7. Defendants have committed acts of patent infringement within this judicial district. Defendants, directly or through intermediaries, import, manufacture, use, sell and/or offer to sell (including through <http://us.blackberry.com>) products such as mobile phones with LTE capability, including for example the BlackBerry Z10 and Q10, in the United States and this district. Upon information and belief, Defendants' products with LTE capability have been used on LTE networks in the United States and elsewhere, including at least one LTE network in this judicial district. Defendants reasonably should

have anticipated being subject to suit in this judicial district. Defendants' acts of patent infringement are aimed at this judicial district and/or have effect in this judicial district.

8. Venue is proper in this Court pursuant to 28 U.S.C. §§ 1391 and 1400(b).

COUNT I

Claim for Direct Patent Infringement of U.S. Patent No. 8,184,661

9. The allegations of paragraphs 1 through 8 are re-alleged as if fully set forth herein.

10. Wi-LAN Inc. is the owner of United States Patent No. 8,184,661 ("the '661 Patent") which duly and legally issued on May 22, 2012.

11. Defendants make, import, sell, use, and/or offer to sell products such as mobile phones that include LTE capability ("LTE Products") in the United States. Examples of LTE Products are Defendants' BlackBerry Z10 mobile phone, which is advertised as including LTE capability (*see* <http://us.blackberry.com/smartphones/blackberry-z10/specifications.html>) and Defendants' BlackBerry Q10 mobile phone, which is advertised as including LTE capability (*see* <http://us.blackberry.com/smartphones/blackberry-q10/specifications.html>). Upon information and belief, the LTE Products comply with and are configured to execute a specific protocol for logical channel prioritization over an LTE network as defined in the 3rd Generation Partnership Project ("3GPP") LTE technical standard when using an LTE network.

12. Upon information and belief, the protocol for logical channel prioritization over an LTE network is a built-in capability that is automatically executed when a user uses Defendants' LTE Products to communicate over an LTE network.

13. Defendants, by making, using, selling, offering for sale and/or importing Defendants' LTE Products that are configured to execute the protocol for logical channel prioritization over an LTE network defined in the 3GPP LTE technical standard, including, for example, the BlackBerry Q10 and Z10, have directly infringed the '661 patent and continue to infringe the '661 patent.

14. Plaintiffs have provided notice pursuant to and in satisfaction of 35 U.S.C. § 287.

15. Plaintiffs have been and continue to be irreparably harmed and monetarily harmed by Defendants' direct infringement of the '661 Patent. If Defendants' infringement is not enjoined, Plaintiffs will continue to be irreparably and monetarily harmed.

COUNT II

Claim for Direct Patent Infringement of U.S. Patent No. 8,274,991

16. The allegations of paragraphs 1 through 15 are re-alleged as if fully set forth herein.

17. Wi-LAN Inc. is the owner of United States Patent No. 8,274,991 ("the '991 Patent") which duly and legally issued on Sep. 25, 2012. Wi-LAN USA, Inc. holds certain exclusive rights under the '991 Patent, including an exclusive right to license Defendants.

18. The 3rd Generation Partnership Project ("3GPP") LTE technical standard defines a protocol for making uplink bandwidth requests over an LTE network.

19. Defendants make, import, sell, use, and/or offer to sell products such as mobile phones that include LTE capability (“LTE Products”) in the United States. Examples of LTE Products are Defendants’ Blackberry Z10 mobile phone, which is advertised as including LTE capability (*see* <http://us.blackberry.com/smartphones/blackberry-z10/specifications.html>) and Defendants’ Blackberry Q10 mobile phone, which is advertised as including LTE capability (*see* <http://us.blackberry.com/smartphones/blackberry-q10/specifications.html>). Upon information and belief, the LTE Products comply with and execute the protocol for making uplink bandwidth requests defined in the 3GPP LTE technical standard when using an LTE network.

20. The use of Defendants’ LTE Products for uplink transmission over an LTE network results in performing a method for obtaining uplink transmission bandwidth as claimed in the ‘991 Patent.

21. Upon information and belief, Defendants (including employees, agents, and representatives of Defendants) have used Defendants’ LTE products’ built-in LTE capability in the United States to directly infringe the ‘991 Patent when obtaining uplink transmission over an LTE network.

22. Plaintiffs have provided notice pursuant to and in satisfaction of 35 U.S.C. § 287.

23. Plaintiffs have been and continue to be irreparably harmed and monetarily harmed by Defendants’ direct infringement of the ‘991 Patent. If Defendants’ infringement is not enjoined, Plaintiffs will continue to be irreparably and monetarily harmed.

COUNT III

Claim for Contributory Patent Infringement of U.S. Patent No. 8,274,991

24. The allegations of paragraphs 1 through 23 are re-alleged as if fully set forth herein.

25. Upon information and belief, Defendants also have been and are infringing by way of contributory infringement, one or more claims of the '991 Patent by their actions relating to making, using, importing, selling and/or offering for sale their LTE Products that incorporate components that are specifically designed to perform a method for obtaining uplink transmission bandwidth as claimed in the '991 Patent to communicate over an LTE network.

26. The use of Defendants' LTE Products to obtain uplink transmission bandwidth over an LTE network results in direct infringement of the '991 Patent.

27. Upon information and belief, the protocol for making uplink bandwidth requests is a built-in capability that is automatically executed when a user uses Defendants' LTE Products to communicate over an LTE network. Upon information and belief, that built-in capability is embedded in one or more components (such as software and/or hardware components, including computer code). Upon information and belief, users of Defendants' LTE Products, including employees, agents, representatives, and customers of Defendants, use the products' built-in LTE capability to directly infringe the '991 Patent when obtaining uplink transmission over an LTE network.

28. Defendants' LTE Products, and in particular the components of Defendants' LTE Products providing the capability of infringing the '991 Patent,

constitute at least a material component of the invention claimed in the '991 Patent in that the products define customer premises equipment programmed to perform a method for obtaining uplink transmission bandwidth as claimed in the '991 Patent. This functionality in Defendants' LTE Products has no substantial non-infringing use and is not a staple article of commerce. Upon information and belief, the built-in components for making uplink bandwidth requests over an LTE network in the manner claimed in the '991 Patent, including the protocol defined in software for transmitting a "Scheduling Request" (SR) using the "PUCCH" without entering into LTE's "Random Access" procedure during a timeout period as provided by the "timeAlignmentTimer," have no use other than for making uplink bandwidth requests over an LTE network in a manner that infringes the '991 Patent. Upon information and belief, the embedded protocol for making uplink bandwidth requests over an LTE network is used only when making an uplink bandwidth request over an LTE network; it is not used when making an uplink bandwidth request of a non-LTE network (such as a 3G network).

29. Defendants know and have known, or have been and remained willfully blind to, the '991 Patent and the fact that their LTE Products, and particularly the components of such products that provide the capability of making an uplink bandwidth request over an LTE network as claimed in the '991 Patent, are especially made or adapted for use in infringing the '991 Patent. For example, on May 8, 2013, Plaintiffs informed Defendants of the '991 Patent and the infringement of such patent associated with the making, selling, offering for sale, importing and using of the LTE Products such as the BlackBerry Z10. Also on May 8, 2013, Plaintiffs provided Defendants with a copy

of a prepared complaint alleging contributory and induced infringement of the '991 Patent associated with the making, selling, offering for sale, importing and using of the LTE Products such as the BlackBerry Z10. That prepared complaint alleged, among other things, that the built-in protocol for making an uplink bandwidth request over an LTE network, was especially made or adapted for use in infringing the '991 Patent, was not a staple of commerce, and had no substantial non-infringing use. Plaintiffs provided such information and the prepared complaint by way of an email sent from Matthew Fox to Noah Webster. Mr. Webster replied to that email, thus confirming its receipt, on May 8, 2013.

30. Prior to filing the instant complaint, Plaintiffs also had filed and served a complaint alleging contributory and direct infringement of the '991 patent in a separate court, associated with the making, using, importing, selling and offering for sale LTE Products such as the BlackBerry Z10. *Wi-LAN USA, Inc. v. Research in Motion Ltd.*, Case No. 1:13-cv-21661-DMM (S.D. Fla. 2013). That complaint was served on Defendants on May 16, 2013.

31. Defendants have not, on information and belief, taken any steps to remove or disable the capability of making infringing uplink bandwidth requests over an LTE network from their LTE Products.

32. Plaintiffs have provided notice pursuant to and in satisfaction of 35 U.S.C. § 287.

33. Plaintiffs have been and continue to be irreparably harmed and monetarily harmed by Defendants' contributory infringement of the '991 Patent. If Defendants'

infringement is not enjoined, Plaintiffs will continue to be irreparably and monetarily harmed.

COUNT IV

Claim for Induced Infringement of U.S. Patent No. 8,274,991

34. The allegations of paragraphs 1 through 33 are re-alleged as if fully set forth herein.

35. Defendants' actions induce infringement of the '991 Patent.

36. Defendants have induced infringement of the '991 Patent, directly or through intermediaries. In their literature and marketing materials, Defendants advertise the LTE capability of the LTE Products and encourage or instruct users to use that capability, which includes making an uplink bandwidth request over an LTE network as covered by the '991 Patent. Examples of such literature and marketing material include without limitation:

<http://us.blackberry.com/smartphones/blackberry-z10/specifications.html>

<http://us.blackberry.com/smartphones/blackberry-z10/overview.html?IID=us:bb:desktop:homepage:Apr2013:hero:bb10-discovermore>

<http://us.blackberry.com/smartphones/blackberry-z10/buy.html>, which provides links to the following:

<http://www.verizonwireless.com/wcms/consumer/devices/blackberry-z10.html> (stating, among other things, "Your BlackBerry Z10 Deserves America's Largest LTE Network")

<http://explore.t-mobile.com/blackberry-10-Z> (stating, among other things, "T-Mobile's new 4G LTE BlackBerry Z10[®] is . . .")

BlackBerry Z10 Smartphone Safety and Product Information Guides

BlackBerry Z10 Smartphone User Guide

BlackBerry Q10 Smartphone Safety and Product Information Guides

BlackBerry Z10 Smartphone User Guide

37. Defendants also have taken specific steps to encourage users of their LTE Products to use the products in an infringing matter by not offering for sale in the United States versions of their LTE Products that are not LTE capable. For example, on information and belief, Defendants sell and offer for sale outside of the United States a version of its Z10 mobile phone that is not LTE capable, but sell and offer for sale in the United States only an LTE capable Z10 mobile phone.

38. Defendants know and have known their acts induce infringement of the '991 Patent. For example, on May 8, 2013, Plaintiffs sent an email to Defendants asserting induced infringement of the '991 Patent and a prepared complaint that included allegations of induced infringement associated with Defendants' making, importing, using, selling and offering for sale LTE Products and encouraging users to use such products on LTE networks.

39. Defendants knew or were willfully blind that use of the LTE Products on LTE networks results in direct infringement of the '991 Patent, and Defendants knew or were willfully blind that they were encouraging users to use the LTE Products on LTE networks as claimed in the '991 Patent. Despite this knowledge, Defendants have continued to encourage users to use the LTE Products on LTE networks and continued to make, use, sell, offer for sale, and import the LTE Products. Upon information and belief, Defendants have and had the specific intent to induce infringement of the '991 Patent.

Upon information and belief, Defendants have taken no steps to discourage or prevent users to use the LTE Products on LTE networks and continued to make, use, sell, offer for sale, and import the LTE Products.

40. Plaintiffs have provided notice pursuant to and in satisfaction of 35 U.S.C. § 287.

41. Plaintiffs have been and continue to be irreparably harmed and monetarily harmed by Defendants' inducement of infringement of the '991 Patent. If Defendants' infringement is not enjoined, Plaintiffs will continue to be irreparably and monetarily harmed.

COUNT V
Willful Infringement of U.S. Patent No. 8,274,991

42. The allegations of paragraphs 1 through 41 are re-alleged as if fully set forth herein.

43. Defendants' infringement is willful. Despite knowledge of the '991 Patent and knowledge that use of the LTE Products on LTE networks infringes the '991 Patent, Defendants have continued to make, use, sell, offer for sale, and/or import LTE Products and have continued to encourage users to use the LTE Products as claimed in the '991 Patent. Upon information and belief, to date, Defendants have not made any changes to the operation of the LTE Products and have not provided their users with instruction on how to avoid infringement since Defendants had notice of the '991 Patent. To date, Defendants have not produced or relied upon an opinion of counsel related to the '991 Patent. To date, Defendants have not produced any evidence of investigation, design

around or remedial actions with respect to infringement of the '991 Patent. Defendants have continued to act despite an objectively high likelihood that their actions constituted infringement of the '991 Patent and this likelihood was known or so obvious that it should have been known to Defendants.

44. Plaintiffs has provided notice pursuant to and in satisfaction of 35 U.S.C. § 287.

45. Plaintiffs have been and continue to be irreparably harmed and monetarily harmed by Defendants' direct and indirect infringement of the '991 Patent. If Defendants' infringement is not enjoined, Plaintiff will continue to be irreparably and monetarily harmed.

PRAYER FOR RELIEF

WHEREFORE, Plaintiffs respectfully request the following relief:

- A. A judgment that Defendants have infringed the '661 Patent;
- B. A judgment that Defendants have infringed the '991 Patent both directly and indirectly;
- C. A judgment and order requiring Defendants to pay all appropriate damages, including enhanced damages, under 35 U.S.C. § 284;
- D. A judgment and order requiring Defendants to pay the costs of this action, including all disbursements, and attorney fees, if this case is exceptional as provided by 35 U.S.C. § 285;
- E. Both preliminary and permanent injunctions against Defendants and their officers, agents, employees, attorneys, and all persons in active concert or participation with them, prohibiting infringement of the '661 Patent;
- F. Both preliminary and permanent injunctions against Defendants and their officers, agents, employees, attorneys, and all persons in active concert or participation with them, prohibiting infringement of the '991 Patent; and
- G. Such other and further relief that this Court may deem just and equitable.

DEMAND FOR A JURY TRIAL

Pursuant to Rule 38 of the Federal Rules of Civil Procedure, Plaintiffs demand a trial by jury of all issues so triable.

Dated: June 25, 2013

Respectfully submitted,

DANIEL SHEEHAN & ASSOCIATES, LLP

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